

REMARKS

Entry of the above amendments to Claims 1 and 71 is respectfully requested in light of the following remarks.

Election/Restriction:

Applicants acknowledge that the election of species is made FINAL.

Rejection of Claim 71 under 35 U.S.C. 112, ¶2:

The Examiner has rejected Claim 71 under 35 U.S.C. 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner contends that the definitions of the variables R^1 - R^7 are unclear.

Although Applicants believe that Claim 71 is definite with respect to the subject matter which Applicants regard as the aspect of their invention as set forth in Claim 71, Applicants have amended Claim 71 to specifically include the definitions of variables R^1 - R^7 . This amendment is fully supported in the Specification as originally filed. Accordingly, Applicants respectfully request that the rejection of Claim 71 under 35 U.S.C. 112, ¶2, be withdrawn and that this Claims be allowed to issue forthwith.

Allowable Subject Matter:

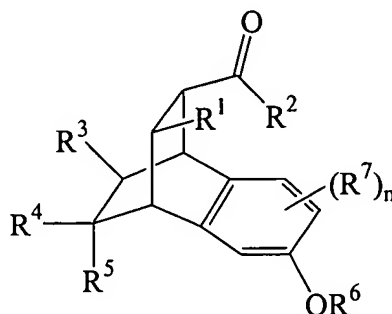
Applicants acknowledge the Examiner's finding that the elected species and its obvious variant is free of the prior art. Applicants also acknowledge that the "obvious variant" is defined where R^1 is $-C(O)OR^9$ where R^9 is *n*-butyl (and all other variants are identical to those of the elected species, *i.e.*, where *n* is zero, R^2 is $-OR^9$ where R^9 is $-CH_2CH_2Si(CH_3)_3$; R^3 is hydrogen; R^4 and R^5 together form the $=O$ group; and R^6 is hydrogen).

The Examiner expanded the search to include the additional species where R^1 is $-C(O)OR^9$ (where R^9 is hydrogen); R^2 is $-OR^9$ (where R^9 is hydrogen); R^3 is hydrogen; R^4 and R^5 together form the $=O$ group; R^6 is hydrogen and *n* is zero. Based on the results of that search, the Examiner issued the following rejection.

Rejection of Claims 1-82 under 35 U.S.C. 102(b):

The Examiner rejected Claims 1-82, is so far as they read on the species defined above, under 35 U.S.C. 102(b) as being anticipated by the compounds disclosed in the CAPLUS abstract for *Tetrahedron* (1970), Vol. 26, No. 6, pp. 1435-1451. .

Using formula (I) as set forth in the instant application, the following compounds are disclosed, *inter alia*, in the CAPLUS abstract:



RN 29073-46-9 (where R¹ is -C(O)OH, R² is -OH, R⁴ and R⁵ together form the =O group, R³ is hydrogen, R⁶ is methyl, and n is zero).

RN 29073-71-0 (where R¹ is -C(O)OCH₃, R² is -OCH₃, R⁴ and R⁵ together form the =O group, R³ is hydrogen, R⁶ is methyl, and n is zero).

Other compounds disclosed in this reference are not within the scope of original Claim 1.

Applicants have amended the proviso of Claim 1 to exclude the two compounds listed above from the scope of Claim 1. Accordingly, Applicants respectfully submit in view of the amendment to the proviso that Claim 1 and dependent compound claims 8, 10-19, 21-22, 25-26, 32-33, 41-44, 46-51, and 58-61, and pharmaceutical composition claim 62 are now not anticipated under 35 U.S.C. 102(b) by the compounds disclosed in the cited reference. Accordingly, Applicants respectfully request that the rejection of these Claims under 35 U.S.C. 102(b) be withdrawn and that the Claims be allowed to issue forthwith.

Furthermore, Applicants further submit that Claims 55-57, which are directed to specific compounds of formula (I), are free and clear of the prior art, as stated by the Examiner with respect to the elected species and obvious variants thereof. Applicants therefore respectfully request that these Claims be allowed to issue forthwith as well.

Furthermore, Applicants submit that Claims 2-7, 20, 23-24, 27-31, 34-40, 45, and 52-57 do not read on the species defined by the expansion of the Examiner's search, and are therefore patentable under 35 U.S.C. 102(b) in light of the teachings of the cited reference. Applicants therefore respectfully request that these Claims be allowed to issue forthwith as well.

Finally, Applicants submit that the reference cited by the Examiner does not anticipate Claims 63-82. These claims are directed to various methods of using and methods of making the compounds of the invention. Such methods of using and making are not disclosed by the cited reference. Accordingly, Applicants respectfully submit that these Claims are patentable under 35 U.S.C. 102(b) in light of the cited reference. Applicants therefore respectfully request that these Claims be allowed to issue forthwith as well.

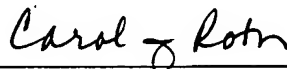
Conclusion:

In summary, Applicants have amended Claim 1 to exclude compounds disclosed in the cited reference and have amended Claim 71 to specifically recite the definitions of R¹-R⁷. Accordingly, in light of these amendments and the foregoing remarks, Applicants respectfully submit that Claims 1-82 are patentable under 35 U.S.C. 112 and 102(b). Favorable consideration of the allowance of these Claims is earnestly solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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